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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,895	09/27/2005	Katsuyoshi Fujiwara	1560-0439PUS1	3722

2292 7590 08/20/2008  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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LEUNG, JACK C

ART UNIT	PAPER NUMBER
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4142

NOTIFICATION DATE	DELIVERY MODE
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08/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,895	<b>Applicant(s)</b> FUJIWARA ET AL.	
	<b>Examiner</b> JACK LEUNG	<b>Art Unit</b> 4142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/22/2006, 9/27/05</u>                                       | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The claims 1-18 are pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7-8, 10-14, and 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claim 7, the claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se. Claims 8 and 10-12 are likewise rejected.

With respect to claim 13, the claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se. Claims 14 and 16-18 are likewise rejected.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 7, 8, 10, 11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Seifert (U.S. Publication No. 2004/0068543 A1).

With respect to claim 7, Seifert teaches a controller capable of registering a partial address (i.e., Group data strings are used to define which incoming e-mails are to be accepted and/or which out-going e-mails are to be transmitted by the e-mail server and/or e-mail client operating on the e-mail user's behalf, wherein group data strings are from at least one of the "From:", "To:", "Subject:" and "Message:" fields of the e-mail under consideration. For example, data strings of one group identify one or more remote e-mail users and/or remote domain names from which e-mail is always to be accepted, sections 11 and 13.) that is in common with a plurality of addresses in a storing unit, among unique addresses that are receiving ends of data (i.e., An e-mail processor comprising means for storing one or more data groups, each group consisting of from none to a plurality of group data strings, section 11); and restricting data transmission to the addresses that contain the partial address registered in said storing unit (i.e., The processor can provide the administrator in an organizational

operating environment with additional controls to determine which incoming e-mails should reach the intended recipient, and which e-mail messages from within the organization are acceptable for transmission, section 12.)

With respect to claim 8, Seifert teaches said controller further capable of interrupting data transmission, when a received address contains no partial address registered in said storing unit (i.e., The processor can include means for permitting the transmission of e-mail meeting the authorization criteria defined by the group data strings for authorizing the transmission of e-mail, and for rejecting the e-mail if none of those criteria are met, section 14).

The limitations of claim 10 are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

With respect to claim 11, Seifert teaches said addresses are e-mail addresses, and said partial address is a domain except for a user name. (i.e., An “e-mail address” is typically the username separated from the domain name by the symbol, “@”, section 7.)

The limitations of claim 13 are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

The limitations of claim 14 are rejected in the analysis of claim 8 above, and the claim is rejected on that basis.

The limitations of claim 16 are rejected in the analysis of claim 10 above, and the claim is rejected on that basis.

The limitations of claim 17 are rejected in the analysis of claim 11 above, and the claim is rejected on that basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifert (U.S. Publication No. 2004/0068543 A1) in view of Malik (U.S. Publication No. 2002/0065891 A1.)

With respect to claim 9, Seifert teaches an input unit for inputting an address of a receiving end (i.e., means of a keyboard, mouse, voice recognition software, etc. in order to generate commands necessary to interact with the communication system, section 31), but it does not disclose wherein said controller is further capable of accepting only an address containing the partial address registered in the storing unit from input. However, Malik teaches wherein said controller is further capable of accepting only an address containing the partial address registered in the storing unit from input (i.e., automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising the steps of storing a list of e-mail addresses in a

Art Unit: 4142

memory, checking if an e-mail address in the e-mail communication is included in the list of e-mail addresses in the memory, and generating a prompt for a user to confirm an e-mail address if the domain name is not included in the list of e-mail addresses, section 20) in order to reduce the occurrence of incorrectly addressed e-mail communications. Therefore, based on Seifert in view of Malik, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Malik to the system of Seifert in order to reduce the occurrence of incorrectly addressed e-mail communications.

The limitations of claim 15 are rejected in the analysis of claim 9 above, and the claim is rejected on that basis.

8. Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifert (U.S. Publication No. 2004/0068543 A1) in view of Nishida (U.S. Patent No. 6,972,858 B1.)

With respect to claim 12, Seifert discloses the claimed subject matter as discussed in the analysis of claim 7 above except that the data transmitting apparatus is an Internet facsimile apparatus that transmits image data. However, Nishida teaches an Internet facsimile apparatus that transmits image data (i.e., transmits image data as an E-mail over the Internet, abstract) in order to automatically recognize whether or not a receiver side has IFAX functions. Therefore, based on Seifert in view of Nishida, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to utilize the teaching of Nishida to the system of Seifert in order to automatically recognize whether or not a receiver side has IFAX functions.

The limitations of claim 18 are rejected in the analysis of claim 12 above, and the claim is rejected on that basis.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACK LEUNG whose telephone number is (571)270-7215. The examiner can normally be reached on Monday thru Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (James) Joon Hwang can be reached on 571-272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/550,895  
Art Unit: 4142

Page 8

Jack Leung  
Patent Examiner

7/29/08

/Joon H. Hwang/  
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